

REMARKS

Reconsideration and allowance in view of the foregoing amendments and the following remarks are respectfully requested.

The original Abstract of the Disclosure has been replaced with a new Abstract of the Disclosure to eliminate a clerical error. That is, administrative clerical markings, which have absolutely no bearing on the disclosure of the invention, were not deleted from the application as filed. Favorable consideration of this amendment is respectfully requested.

The Rejection Under 35 U.S.C. §102(b)

Claims 1-4, 7, 8, 10-12, 15, 16, 18-21, 24, and 25 were rejected as being anticipated by Coughlin, *et al.*, (U.S. Patent 6,810,411; hereafter "Coughlin"). The Applicant respectfully traverses this rejection because the rejection does not fulfill the requirements of an anticipation rejection as set forth in MPEP §2131. Therefore, the Applicant respectfully requests that this rejection be reconsidered and withdrawn.

MPEP §2131 states, in part:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicant submits that Coughlin does not set forth *each and every element* of the presently rejected claims, either expressly or inherently.

For instance, **Claim 1** recites, in part, a step of:

first transmitting, via at least the second network interface, a name query request corresponding to the network resource name service request.

The rejection asserts that this recited step is taught by one or name servers 160, which resolves an IP (internet protocol) address of a domain name over network 150 (Coughlin, FIG. 1, col. 4, lines 7-13). However, this comparison of server 160, as taught by Coughlin,

to the recited “at least the second network interface” reveals a patentable distinction between Claim 1 and Coughlin.

More particularly, Claim 1 concludes with the step of:

second receiving in response to the first transmitting step, by the machine via the second network interface, a name query response including a network address for the resource residing on the subnet coupled to the machine via the second network interface.

On the other hand, Coughlin describes a third interface, namely authoritative server 140, as responding with at least one IP address for the host of a requested domain name. That is, Coughlin does not teach a machine receiving a name query response via the second network interface, as in Claim 1, contrary to the assertion of the present rejection.

Accordingly, for at least the reasons set forth above, the Applicant respectfully submits that Claim 1 is not anticipated by Coughlin. Further, due to their dependency upon Claim 1, is it respectfully submitted that dependent **Claims 2-4, 7, and 8** are similarly distinguishable over Coughlin.

Further still, it is submitted that the computer-readable medium of **Claims 10-12, 15, and 16**, as well the network server machines recited in **Claims 18-21, 24, and 25** are distinguishable over Coughlin for at least the same reasons set forth above regarding Claims 1-4, 7, and 8. By such submission, the Applicant does not acquiesce, or otherwise imply, that Claims 10-12, 15, 16, 18-21, 24, and 25 are of the same scope as Claims 1-4, 7, and 8. Rather, the rejection merely states that such claims are rejected under the same rationale as Claims 1-4, 7, and 8, and, under such rationale, the Applicant submits that Claims 10-12, 15, 16, 18-21, 24, and 25 are patentably distinguishable over Coughlin.

Thus, the Applicant respectfully request that the outstanding rejection under 35 U.S.C. §102 be reconsidered and withdrawn.

The Rejection Under 35 U.S.C. §103(a)

Claims 5, 6, 9, 13, 14, 22, 23, and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Coughlin in view of Pontoppidan, *et al.*, (U.S. Patent Publication 2002/0161872; hereafter "Pontoppidan"). The Applicant respectfully traverses this rejection as well, and requests that this rejection also be reconsidered and withdrawn.

It is respectfully submitted that the arguments provided above to patentably distinguish independent Claims 1, 10, and 18 further serve to distinguish the presently rejected dependent Claims 5, 6, 9, 13, 14, 22, 23, and 26 over Coughlin. That is, the base claims from which each of the presently rejected dependent claims respectively depends have been distinguished from Coughlin.

Further, it is respectfully submitted that Pontoppidan does not compensate for the deficiencies of Coughlin with regard to the base claims, nor does the rejection provide any argument to that effect. For example, whereas Coughlin does not teach a machine receiving a name query response via the second network interface, as recited in Claim 1, Pontoppidan provides no remedy. Thus, since such distinguishing feature may be applied to each of base Claims 1, 10, and 18, it is respectfully submitted that the proposed combination of Coughlin and Pontoppidan are insufficient to establish a *prima facie* case of obviousness with regard to the presently rejected dependent claims.

More specifically, one of the three basic requirements for establishing a *prima facie* case of obviousness, as set forth in MPEP §2143 is, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." Clearly, as established by the Applicant, Coughlin and Pontoppidan fail to teach or suggest fundamental features of the base claims from which the presently rejected dependent claims depend, and therefore Claims 5, 6, 9, 13, 14, 22, 23, and 26 are clearly not rendered obvious by the proposed combination of references.

Therefore, it is respectfully requested that the outstanding rejection under 35 U.S.C. §103 be reconsidered and withdrawn.

Conclusion

The remaining references of record have been studied. It is respectfully submitted that they do not compensate for the deficiencies of the references utilized to reject the pending claims.

All objections and rejections having been addressed, it is respectfully submitted that the present application is now in condition for allowance. Early and forthright issuance of a Notice to that effect is earnestly solicited.

Respectfully submitted,

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